UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,910	12/24/1998	THOMAS E. WALSH	2207-6033	5446

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EXAMINER
VU, THONG H

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 October 2002</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>2,5-15,17-21 and 23-41</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>2,5-15,17-21 and 23-41</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

1.   The appendix B filed may 12, 2003 (paper #14), page 22 identified the Appeal

Application as 09/506,436 instead of 09/220,910. Correction is required.

2.   In view of the Amendment C, filed on 10/02/02, PROSECUTION IS HEREBY

REOPENED. The Non-Final rejection is cited as set forth below.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a

supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or

1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 2,5-15,17-21,23-41are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the written description requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention. (i.e: an un-specified location relative

to a primary document)

Claims 2,5-15,17-21,23-41are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the enablement requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to enable one skilled in

the art to which it pertains, or with which it is most nearly connected, to make and/or use

the invention. (i.e: an un-specified location relative to a primary document).

Claim Rejections - 35 USC § 112

Claims 2,5-15,17-21,23-41 are rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention. It was unclear that How many

indicators in the primary document and What kind/type of indicator a user is looking for

selection. Examiner considers anything of the primary document could be the un-

selected indicator (i.e.: keyword, number, drawing, image)

Response to Arguments

4.   A. As per claims 2,5-15,17-21,23-41 applicant argues the prior art does not

teach "locate an un-selected indicator".

Examiner notes the specification does not disclose un-selected indicator.

Examiner interpret the un-selected indicator as an indicator, pointer, locator, URL,

address, etc.

B. As per claims 2,5-15,17-21,23-41 applicant argues the prior art does not

teach "attaching said secondary document to said primary document to encapsulate

said secondary document within said primary document".

Examiner interprets "attaching said secondary document to said primary

document to encapsulate said secondary document within said primary document" is

equivalent to an attached file to a document, file, email or electronic message

[Wanatabe col 9 lines 60-col 10 line 2] .

5.   Claims 2,5-15,17-21,23-41 are rejected under 35 U.S.C. § 103 as being obvious

over Krause [5,526,520] in view of Wanatabe [6,372,612 B1].

6.   As per claims 2,27 Krause discloses a method for identifying a secondary

document having an un-specified location relative to a primary document in a document

preparation environment comprising:

determining if said primary document includes an indicator (i.e.: file name)

[Krause, a file is identified by a name, col 3 lines 62-65]; and

identifying said secondary document (i.e.: additional text, audio, video) by

determining at least one of a filename and a location of said secondary document (i.e.:

file name and label) [Krause, the indicating means includes a name and lable, col 4

lines 44-50] using at least one of a user input [Krause, clicking, col 4 lines 51-65], a user

selection and syntactic processing (i.e.: sign, symbol, drawing, graphic, icon) of said

primary document, if said primary document includes said indicator [Krause, a user may

select a number of specific blueprint files and access at a time, col 4 line 66-col 5 lines 10; col 4 lines 15-65; col 9 line 28-col 10 line 27]

Krause does not explicitly detail attaching said secondary document to said primary document to encapsulate said primary and secondary documents together, if said primary document includes said indicator.

It is well-known in the e-mail art that the email as the first document could has an attached document as secondary document. A skilled artisan would have motivation to implement Krause's apparatus and found Watanabe, Watanabe, in a same endeavor, discloses an email processing system including the email body text as the first document and the second document as an attachment file embedded in email message (i.e.: text, graphic, symbols) [Wanatabe col 9 lines 60-col 10 line 2]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the Krause and Wanatabe's teaching in order to utilize the technique of embedded a message into an email body. Doing so it would provide the fast and easy way to send the multi attached files to client through a message such as an email on Internet.

7.   As per claims 17,23,30,33 Krause-Wanatabe disclose a system for identifying a secondary document having an un-specified location from a primary document comprising:

a first storage device storing said primary document (ie.: data creation) [Wanatabe Fig 3];

a second storage device storing said secondary document (i.e.: database)

[Wanatabe Fig 3];

a third storage device storing an indicator (i.e.: recipient address input)

[Wanatabe Fig 3];

a processor [Wanatabe, col 7 lines 15-28] coupled to said first storage device;

said second storage device and said third storage device, said processor determining if

said primary document includes said indicator, identifying said secondary document by

determining at least one of a file name and a location of said secondary document using

at least one of user input, a user selection and syntactic processing if said primary

document includes said indicator, attaching said secondary document to said primary

document to encapsulate said primary and secondary documents together, if said

primary document includes said indicator [see rejection claims 1,27].

Examiner takes an Official notice that a database server / router and

administrator server could be located on the same or different machine.

8.   As per claims 5,18,24 Krause-Wanatabe disclose said primary document

includes at least one word, and wherein determining at least one of said file name and

said location of said secondary document is performed as a function of said at least one

word as an inherent feature of frame name [Krause col 6 line 35-col 7 line 28].

9.   As per claims 6,34 Krause-Wanatabe disclose said primary document includes a

plurality of words, and wherein determining at least one of said filename and said

location of said secondary document is performed as a function of said plurality of

words within a predetermined proximity of said indicator included in said plurality of

words as an inherent feature of frame name [Krause col 6 line 35-col 7 line 28].

10.   As per claims 7, 19 Krause-Wanatabe disclose associating a predetermined

word with at least one of said filename and said location of said secondary document,

wherein said primary document includes said predetermined word, and wherein

identifying at least one of said filename and said location of said secondary document is

performed as a function of said predetermined word as an inherent feature of frame

name [Krause col 6 line 35-col 7 line 28].

11.   As per claims 8,20,25,28 Krause-Wanatabe disclose said indicator includes at

least one of a plurality of predetermined words, a plurality of predetermined characters,

and a plurality of predetermined phrases as an inherent feature of frame name [Krause

col 6 line 35-col 7 line 28].

12.   As per claims 9,21,26 Krause-Wanatabe disclose determining if said at least one

word includes one of said indicator is performed using syntactic processing or menu

[Krause col 6 line 35-col 7 line 28].

13.   As per claim 10, Krause-Wanatabe disclose the primary document is an email

message [Wanatabe col 2 lines 34-52].

14.   As per claim 11, Krause-Wanatabe disclose disclose sending said e-mail

message and said secondary document attached thereto to a recipient via a

communications device [Wanatabe col 3 lines 15-57].

15.   As per claim 12, Krause-Wanatabe disclose sending said primary document and

said secondary document attached thereto to a printing device [Krause col 2 line 48].

16.   As per claim 13, Krause-Wanatabe disclose said primary document and said

secondary document attached thereto to a recipient via facsimile or scanner [Krause col

2 line 48].

17.   As per claim 14, Krause-Wanatabe disclose said secondary document is

attached to said primary document at a first instance, said first instance being

determined as a function of a user input [Krause col 6 lines 35-45].

18.   As per claims 15,36,37 Krause-Wanatabe disclose adding at least one additional

indicator to said indicator as a function of a user input (or selection) [Krause col 6 lines

35-45][Wanatabe col 3 line 58-col 4 line 3,col 7 lines 55-67,col 9 lines 35-43, col 12

lines 12-23].

19.   As per claim 29, Krause-Wanatabe disclose said primary document includes a

list of at least one address corresponding to at least one recipient to receive said

primary document, further comprising attaching said address of said recipient to said list

of said at least one address as inherent feature of email message wherein an email is

primary document includes an indicator as an address of recipient [Wanatabe col 3 lines

15-57].

20.   Claims 2,5-15,17-21,23-41 are rejected under 35 U.S.C. § 103 as being obvious

over Bobo, II [5,675,507] in view of Fabbio [5,870,089].

21.   As per claims 2,27 Bobo discloses the invention as substantially as claimed, a

method for message storage and delivery system wherein a second document (i.e.:

HTML image) is embedded into a first document (i.e.: facsimile message) [Bobo col 9

line 47-col 10 line 25,col 21 lines 55-60, col 22 lines 49-60] which is equivalent to a

method for identifying a secondary document having an un-specified location relative to

a primary document in a document preparation environment;

        determining if said primary document includes an indicator (i.e.: message ID,

address, file name) [Bobo col 7 lines 38-50]; and

        attaching said secondary document to said primary document to encapsulate

said primary and secondary documents together, if said primary document includes said

indicator [Bobo col 9 line 46-col 10 line 14]

        Bobo is silent to detail identifying said secondary document by determining at

least one of a filename and a location of said secondary document using at least one of

a user input, a user selection and syntactic processing (i.e.: sign, symbol, drawing, graphic, icon) of said primary document, if said primary document includes said indicator.

It is well-known in the e-mail art that the email as the first document could has an attached document as secondary document. A skilled artisan would have motivation to implement Bobo's apparatus and found Fabbio. Fabbio, in a same endeavor, discloses an electronic package processing system (i.e.: email, facsimile message) including the document references such as file names and locations [Fabbio, abstract, Fig 1, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the Fabbio into Bobo's teaching in order to utilize the technique of embedded or attached a second message into the first message. Doing so it would provide the fast and easy way to send the attached files to client through a large network such as Internet.

22. As per claims 17,23,30,33 Bobo-Fabbio disclose a system for identifying a secondary document having an un-specified location from a primary document comprising:

a first storage device storing said primary document [Bobo Fig 13-15];

a second storage device storing said secondary document [Bobo Fig 13-15];

a third storage device storing an indicator [Bobo Fig 13-15];

a processor [Bobo Fig 13-15] coupled to said first storage device; said second

storage device and said third storage device, said processor determining if said primary

document includes said indicator, identifying said secondary document by determining

at least one of a file name and a location of said secondary document using at least one

of user input, a user selection and syntactic processing if said primary document

includes said indicator, attaching said secondary document to said primary document to

encapsulate said primary and secondary documents together, if said primary document

includes said indicator [see rejection claims 1,27].

23.   As per claims 5,18,24 Bobo-Fabbio disclose said primary document includes at

least one word, and wherein determining at least one of said file name and said location

of said secondary document is performed as a function of said at least one word

locations [Fabbio, abstract, Fig 1, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

24.   As per claims 6,34 Bobo-Fabbio disclose said primary document includes a

plurality of words, and wherein determining at least one of said filename and said

location of said secondary document is performed as a function of said plurality of

words within a predetermined proximity of said indicator included in said plurality of

words locations [Fabbio, abstract, Fig 1, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines

25].

25.   As per claims 7, 19 Bobo-Fabbio disclose associating a predetermined word with

at least one of said filename and said location of said secondary document, wherein

said primary document includes said predetermined word, and wherein identifying at

least one of said filename and said location of said secondary document is performed

as a function of said predetermined word locations [Fabbio, abstract, Fig 1, col 2 lines

38-55,col 3 lines 4-44, 58-col 4 lines 25].

26.   As per claims 8,20,25,28 Bobo-Fabbio disclose said indicator (i.e.: references)

includes at least one of a plurality of predetermined words, a plurality of predetermined

characters, and a plurality of predetermined phrases locations [Fabbio, abstract, Fig 1,

col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

27.   As per claims 9,21,26 Bobo-Fabbio disclose determining if said at least one word

includes one of said indicator is performed using syntactic processing [Bobo Fig

15][Fabbio Fig 7-7A].

28.   As per claim 10, Bobo-Fabbio disclose the primary document is an email

message locations [Fabbio, abstract, Fig 1-2, col 2 lines 38-55,col 3 lines 4-44, 58-col 4

lines 25].

29.   As per claim 11, Bobo-Fabbio disclose sending said e-mail message and said

secondary document attached thereto to a recipient via a communications device

locations [Fabbio, abstract, Fig 1-2, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

30.   As per claim 12, Bobo-Fabbio disclose sending said primary document and said

secondary document attached thereto to a printing device [Fabbio abstract].

31.

32.   As per claim 13, Bobo-Fabbio disclose said primary document and said

secondary document attached thereto to a recipient via facsimile or scanner locations

[Fabbio, abstract, Fig 1-2, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

33.   As per claim 14, Bobo-Fabbio disclose said secondary document is attached to

said primary document at a first instance, said first instance being determined as a

function of a user input locations [Fabbio, abstract, Fig 1-7A, col 2 lines 38-55,col 3 lines

4-44, 58-col 4 lines 25].

34.   As per claims 15,35,36 Bobo-Fabbio disclose adding at least one additional

indicator to said indicator as a function of a user input locations [Fabbio, abstract, Fig 1-

7A, col 2 lines 38-55,col 3 lines 4-44, 58-col 4 lines 25].

35.   As per claim 29, Bobo-Fabbio disclose said primary document includes a list of at

least one address corresponding to at least one recipient to receive said primary

document, further comprising attaching said address of said recipient to said list of said

at least one address locations [Fabbio, abstract, Fig 1, col 2 lines 38-55,col 3 lines 4-44,

58-col 4 lines 25].

36. As per claims 35,38 Bobo-Fabbio disclose using syntactic processing (or natural

language processing) of said primary document as inherent feature of primary
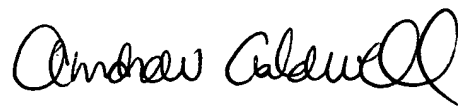
document or file.

37. As per claims 39-41 Bobo-Fabbio disclose processing said primary document to

locate one of a plurality of pre-determined phrase/words/characters as inherent feature

of primary document or file.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (571) 272-3896. The fax number for the organization where this application or proceeding is assigned is 703-872-9306

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